

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Art Unit 2135

Rhoads et al.

Conf. No: 9322

Application No.: 09/858,189

Filed: May 14, 2001

For: CONTENT IDENTIFIERS TRIGGERING  
CORRESPONDING RESPONSES

**VIA ELECTRONIC FILING**

Examiner: H. Song

Date: January 19, 2007

**APPLICATION FOR PATENT TERM ADJUSTMENT**  
**(Request for Reconsideration of PTO's Patent Term Adjustment Determination)**  
**(37 CFR 1.705(b))**

Sir,

Applicants request reconsideration of the patent term adjustment indicated in the Notice of Allowance.

Please charge the \$200 fee set forth in §1.18(e) to Deposit account 50-1071.

**Statement of Facts Involved**

The PTO's calculations of both Applicant Delay, and PTO Delay, are believed to be in error.

The Applicant Delay is said to include 174 days from December 19, 2003 (Mail Non-Final Rejection) to September 9, 2004 (Response After Non-Final Rejection). During this period, the application was held abandoned, and then the abandonment was rescinded.

Following the December 19, 2003 Non-Final Rejection, a responsive Amendment was timely mailed, and received by the PTO on March 22, 2004 (copy of PTO-stamped postcard attached). However, the PTO apparently failed to match the documents to the file, and the application wrongfully went abandoned.

Promptly upon learning of the abandonment, Applicant filed a Petition to Withdraw Holding of Abandonment (September 9, 2004).

The PTO granted the Petition (decision mailed January 18, 2005, copy attached). In the Decision, the PTO acknowledged its mistake.

Because the abandonment was due to PTO error (per January 18, 2005 Decision)), the 174 days of delay charged to applicants should be reconsidered.

Applicants believe the proper Applicant Delay to be charged in connection with this time period is as follows:

3 days: for the time period March 19-22, 2004 (the 3 month response deadline for the Non-Final Rejection was March 19; the responsive Amendment was timely mailed on March 18, 2004, but was not received by the PTO until March 22).

Thus, instead of an Applicant Delay of 174 days during this period, the correct number is believed to be 3 days. Thus, the net Applicant Delay should be reduced by the difference of 171 days, i.e., from 181 days to 10 days.

Relatedly, the PTO delay is believed to be greater than calculated. Applicants' Amendment was filed on March 22, 2004. The PTO had 4 months to make a timely response, i.e., until July 22, 2004. However, it did not respond to the Amendment (by a Final Rejection) until April 18, 2005. Thus, the PTO introduced a delay of 270 days.

The previous PTE calculation allocated only 101 days for PTO delay during this period (i.e., from four months after the date on which the Amendment was resubmitted with the September 9, 2004 petition, to the mailing date of the Final Action on April 18, 2005). Thus, the PTO's total delay should be increased by the difference between the corrected delay of 270 days, and the earlier attributed delay of 101 days, i.e., 169 days.

This increases the PTO's total delay from 624 days to 793 days.

The correct Patent Term Extension is thus believed to be the excess of the PTO's corrected total delay (793 days) over the Applicants' corrected total delay (10 days), i.e., 783 days.

(Applicants may be entitled to additional Patent Term Extension if the patent issues after March 28, 2007, i.e., more than four months after applicants' November 28 payment of the issue fee.)

The patent application is not subject to a Terminal Disclaimer.

There were no circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of the application – other than those already considered in the PTO's earlier determination of patent term adjustment.

Date: January 19, 2007


**CUSTOMER NUMBER 23735**

Phone: 503-469-4800  
FAX 503-469-4777

Respectfully submitted,

DIGIMARC CORPORATION

By

  
\_\_\_\_\_  
William Y. Genwell  
Registration No. 31,943

COPY

Receipt is hereby acknowledged by the U.S. Patent and  
Trademark Office of the following: Amendment, IDS, Form  
PTO-1449 with cited references and transmittal letter with  
deposit account authorization.

✓  
1/2  
Inventor: Rhoads et al.  
Appn No. 09/858,189  
Filed May 14, 2001  
Digimarc Corporation

WYC:imp P0376

March 18, 2004





UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

MAILED

JAN 18 2005

Technology Center 2100

Paper No. 9

COPY

WILLIAM Y. CONWELL  
DIGIMARC CORPORATION  
9405 SW GEMINI DRIVE  
BEAVERTON, OR 97008

In re Application of: Rhoads et al.

Application No.: 09/858,189

Filed: May 14, 2001

Attorney Docket No.: P0376

For: CONTENT IDENTIFIERS TRIG-  
GERING CORRESPONDING RESPONSES

) **DECISION GRANTING PETITION**  
) **TO ACCEPT CORRESPONDENCE AS**  
) **TIMELY FILED UNDER 37 CFR §1.8**  
) **(b) AND WITHDRAW HOLDING OF**  
) **ABANDONMENT UNDER 37 CFR**  
) **1.181**

This decision is in response to the petition filed September 9, 2004 to withdraw the holding of abandonment under 37 CFR § 1.181 and 1.8(b). The petition is being treated as a request to accept papers as timely filed. The Notice of Abandonment was mailed August 25, 2004.

In support of the petition, the practitioner has provided a personal knowledge statement along with a copy of an amendment with a certificate of mailing, a copy of an information disclosure statement (IDS) and accompanying transmittal letter with a fee authorization for the IDS and a copy of a stamped postcard receipt with a stamped date of March 22, 2004. The USPTO postcard receipt that itemizes and properly identifies the items that are being filed serves as *prima facie* evidence of receipt in the USPTO of all the items listed thereon on the date stamped by the USPTO.

The evidence provided establishes that a timely response to the office action of December 19, 2003 was, in fact, received on March 22, 2004. The Office failed to match the complete response to the application file. A review of the application record shows the prior art submitted with the IDS was, in fact, matched to the application and the appropriate fee charged. Therefore, applicants do not need to resubmit the references. However, applicants are advised that the Office is no longer accepting papers which are double-sided and any such papers filed to date should be resubmitted as single-sided copies (37 CFR 1.52(a)(1)(iii) revised June 30, 2003 and effective July 30, 2003).

The petition is **GRANTED**. The application was not abandoned in fact. The Office regrets any inconvenience caused by this error.

The application will be forwarded to the Technical Support Staff for processing of the response to the Office action that was filed March 22, 2004. No additional fee is required for the accompanying IDS since the fee was charged on March 22, 2004. Thereafter, the application will be forwarded to the examiner for consideration of applicants' amendment.

Josie A. Ballato

Special Programs Examiner

Technology Center 2100

Computer Architecture, Software, and Information Security